

REMARKS

Claims 1-13, and 17-19 are pending in this application. A Request for Continued Examination is filed in this application, and claim 1 is currently amended. The basis of the amendment is found at page 18, line 20 to page 19, line 10 (in particular, page 18, lines 2-24 and page 18, line 27 to page 19, line 2).

Reconsideration of the objection and rejection in view of the amendment and the following remarks is respectfully requested.

(1) Claims 1-2, 17-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al. (5,134,056) in view of Kono et al (6,346,678).

The present invention is distinct from Kono et al. in view of the recitation of "exposing the solder resist material to the ultraviolet ray through the unexposed portion of the light shielding mask." According to the present invention, an ultraviolet ray is exposed through the unexposed portion of the light shielding mask while the exposed portion is maintained, but the exposed portion in Kono et al. is developed or removed as disclosing that the hole 5 for irradiation is formed by chemical development (col. 1, lines 45-47). Therefore, even by combining Schmidt et al. with Kono et al., the method claims 1-2 and 17-19 cannot be obtained.

In addition, there must be a basis in the art for combining or modifying references. The mere fact that the references can be combined or modified does not render the resultant combination obvious, unless the prior art also suggest the desirability of the combination. The office action

alleges that the missing elements of Schmidt et al. would have been obvious to one skilled in the art at the time of claimed invention to form the conductor patterns on the board using a photolithographic technique using a laser beam, as supported by Kono et al. This by itself does not suggest the desirability of the combination.

Also, prima facie obviousness requires a reasonable expectation of success. However, there is no suggestion that the photolithographic technique of Kono et al. would be tried in the method of Schmidt et al. An obvious to try standard is not a proper basis for a rejection under 35 U.S.C. 103.

(2) Claims 3 and 4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al. (5,134,056) in view of Kono et al. (6,346,678) as applied to claims 1-2, 14-19 above, and further in view of Ohsumi et al. (6,001,537).

Claims 3 and 4 depend on claim 1. Claim 1 is believed to be in a condition of allowance, as described above.

As described above, the present invention is distinct from Ohsumi et al. in view of the recitation of "exposing the solder resist material to the ultraviolet ray through the unexposed portion of the light shielding mask." In the disclosure of Ohsumi et al, an ultraviolet ray is irradiated through the opening of the mask, but according to the present invention, an ultraviolet ray is exposed through the unexposed portion of the light shielding mask. The unexposed portion of the light shielding mask is maintained in the step of the ultraviolet ray exposure. Therefore, even if combining the "Modified Schmidt et al." with Ohsumi et al., the method of claims 3-4 cannot be obtained.

Further, there must be a basis in the art for combining or modifying references. The mere fact that the references can be combined or modified does not render the resultant combination obvious, unless the prior art also suggest the desirability of the combination. The office action alleges that the missing elements of the "Modified Schmidt et al." are provided by the disclosure of Ohsumi et al. This by itself does not suggest the desirability of the combination.

Also, prima facie obviousness requires a reasonable expectation of success. There is no suggestion that the exposure method of Ohsumi et al. would be tried in the "Modified Schmidt et al." An obvious to try standard is not a proper basis for a rejection under 35 U.S.C. 103.

(3) Claims 5-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al (5,134,056) in view of Kono et al (6,346,678) as applied to claims 1-2 and 14-19 above, and further in view of Shinmoto et al (5,897,938).

Claims 5-13 directly or indirectly depend on claim 1. Claim 1 is believed to be in a condition of allowance, as described above. Further, there must be a basis in the art for combining or modifying references. The mere fact that the references can be combined or modified does not render the resultant combination obvious, unless the prior art also suggest the desirability of the combination. Also, prima facie obviousness requires a reasonable expectation of success. An obvious to try standard is not a proper basis for a rejection under 35 U.S.C. 103.

(4) It is submitted that nothing in the cited references, taken either alone or in combination, teaches or suggests the features recited in each claim of the present invention. Thus, all pending

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claims are believed to be in condition for allowance. Reconsideration of the rejections, withdrawal of the rejections and an early issue of a Notice of Allowance are earnestly solicited.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees which may be due with respect to this paper, may be charged to Deposit Account No. 01-2340.

Respectfully submitted,

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